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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/454,865      | 12/07/1999  | SHINICHIRO TANIGUCHI | 104934              | 4339             |

25944 7590 12/21/2005

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| EXAMINER |
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COLIN, CARL G

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2136

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|   |                                      |   |  |
|---|--------------------------------------|---|--|
| <b>Advisory Action</b><br><b>Before the Filing of an Appeal Brief</b> | <b>Application No.</b><br>09/454,865 | <b>Applicant(s)</b><br>TANIGUCHI ET AL. |  |
|   | <b>Examiner</b><br>Carl Colin        | <b>Art Unit</b><br>2136                 |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 20 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

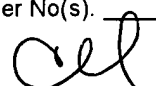
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 1-27.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).  
 13. ☒ Other: Interview Summary held on 10/13/05 Paper No. 20051215.

  
 Primary Examiner  
 AVZ/31  
 12/14/05

Continuation of 11. does NOT place the application in condition for allowance because: The reply filed on 10/20/2005 is not fully responsive because it fails to include a complete or accurate record of the substance of the October 13 interview held with Applicant's Representative, Daniel Tanner, III, Examiner, Colin and Examiner's Supervisor, Ayaz Sheikh. Applicant's reply on 10/20/2005 falsely states "Applicants have not been afforded the requisite specificity in the rejections of the claims enumerated in the Office Action to adequately respond". Examiner would like to clarify for the record that another interview after the October 6 interview took place with Applicant's Representative as indicated above in order to advance the prosecution. As per Applicant's Representative, Daniel Tanner, III, request on October 13, a fax document of 6 pages (including the cover page) with detailed explanation specifying the elements of the independent claims rejected in the Final Office Action was faxed to Applicant's Representative on October 17 (see attached). Although the Tax Report (see attached) indicated that the Fax was received, Examiner left a message the same day on Daniel Tanner, III's machine to notify that the Fax was sent as requested. The same week, Examiner called again Applicant's Representative, Daniel Tanner, III, who personally confirmed that he received the faxed document.

Applicant's arguments filed 10/20/2005 have been fully considered but they are not persuasive. Applicant argues that the Office Action uses: qualifiers as "substantially discloses" "suggests" and numerous paragraphs e.g. column 2, line 47-col.3 line 35 as disclosing small number of elements. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Regarding Applicant's argument about the memory card of Bauer, Applicant was provided with clarification of the claimed elements disclosed as discussed above. Again, Applicant's fails to admit that there was a request for clarification of what the memory card corresponded to and clarification was given to Applicant by Examiner (see below, taken from document received by Applicant on 10/17/05),

"a memory card (2), (first information verification unit) comprising:

a computer (32), (first verification part), for read write access and suggests using access code that meets the recitation of a first information verification unit comprising a first verification part that verifies the information read out from the data carrier a first verification key storage part (33 and 34) that stores the verification key used by the first information verification part for verification of the information, for example (see column 2, lines 15-25 and column 6, lines 1-55);

an information generating unit (41) that processes the information to be stored in the data carrier comprising: distribution information generating part (44) that generates the information to be stored in the data carrier (see column 2, lines 24-38 and column 6, lines 38-65)."

In response to applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is at least teaching, suggestion and/or motivation provided by the references themselves as indicated in the last Final Office Action and as indicated in the October 6 interview (see Sudia's summary of invention). Applicant stated, "Examiner Colin indicated that because signature verification is "well known in the art" and Sudia discloses a multi-step signing system, Sudia can be combined with Bauer. This rationale fails to address Applicants' specific arguments, as enumerated above, that Applicants' representative attempted to present during the personal interview."

Applicants' representative again erroneously presents the facts: Examiner responded "signature verification is well known in the art as disclosed by applicant in the specification and Sudia discloses a multi-step signing system which can be combined with Bauer" (see interview summary record 10/6/05 given and read by Applicant's Representative Daniel Tanner, III, in presence of Examiner to acknowledge what was discussed in the interview. In fact, Applicant's disclosure page 3, admits "The digital signature technique has been known as a technique to put a signature on the distribution information..."

Applicant adds "There is nothing in Bauer to suggest the multiple layers of security recited in the pending claims" by attacking a single reference in an obviousness rejection where the rejections are based on combinations of references. Applicant further misinterprets Sudia's invention by selecting the first sentence of the abstract and the first sentence of the summary to summarize the invention disclosed by Sudia. Applicant fails to address "the multi-layered authorization management system" of Sudia and the teaching of the multi-step signing system among many other features (see for instance Sudia's summary of invention and last Final Office Action).

In response to applicant's argument that "It is hardly conceivable, despite the assertions to the contrary in the Office Action, that one of ordinary skill in the art of goods distribution management at the time this application was written would have combined the teachings of the system for controlling and monitoring distribution of goods of Bauer with the cryptographically-based signing system for electronic documents disclosed in Sudia", the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

For at least the reasons cited above and in the previous office actions, the request for reconsideration has been considered but does not place the application in condition for allowance.